REMARKS

Claims 1-5, 8-14, 16-29, and 30-38 are pending. Claims 1-5, 8-14, 16-29, and 30-38 are rejected. Claims 6-7 and 15 are canceled. The first instance of claim 30 has been previously canceled; the second instance of claim 30 is currently pending.

Amendments to the Claims

Claims 1, 8, 10, 12 and 28 are amended with merely clarifying amendments. Support for these amendments may be found throughout the specification, for example, on page 5, lines 1-12; and on page 6, lines 5-7 ("a telephone call is ongoing and the provided options are temporarily adapted to include "send to caller" as an additional option"); and page 4, lines 19-20 ("The control means 30 is provided, in this example, by a suitably programmed processor").

Claims 39-40 are newly added. Support for these claims may be found throughout the specification, for example, claims 1 and 12 as originally filed and on page 8, lines 13-14.

The second instance of claim 30 is canceled and added as claim 41. Claims 31-32 have been amended to correct the dependencies.

No new matter is added.

Claim Rejection - 35 U.S.C. 103(a)

The Examiner has rejected claims 1-5, 8-14, 16-19 and 33-34 as being unpatentable under 35 U.S.C. 103(a) over Preston, et al. (U.S. Patent No. 6,493,338), herein Preston, in view of Lielbriedis (U.S. Patent Pub. No. 2001/0051528), herein Lielbriedis; and claims 36-38 as being unpatentable under 35 U.S.C. 103(a) over Preston in view of Lielbriedis in view of Paik et al. (U.S. Patent Pub. No. 2008/0153471), herein Paik. The Applicants include the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully request a favorable reconsideration of claims 1-5, 8-14, 16-19, 33-34 and 36-38.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as

interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.[1]

Regarding claim 1 , which recites:

> "A method comprising:
> in a terminal of a first party participating in a telephone call, storing, **as a consequence of the** telephone call, identifier data that identifies a second party **participating in the telephone call**;
> using the stored identifier data **to determine** automatically a **destination address** for a data message; and
> controlling a transmitter to send, **during the telephone call,** a data message with the automatically determined **destination address,** wherein said transmitter is controlled to send said data message **out-of-band** relative to the telephone call." (emphasis added).

The Examiner observes that Preston does not disclose "storing an identifier and using the stored identifier to automatically determine a destination address for a data message". It is noted that Preston discloses "**inband** signaling modem communicates digital data over a voice channel of a wireless telecommunications network" (Abstract, emphasis added). In other words, when a telephone call – which inherently includes a voice channel – has been set up and is in use for speech, Preston suggests using an encoder to convert the digital data into audio tones and to output these audio tones to the voice channel (see Abstract). There would be no need to determine any specific destination address for the data message in Preston, because the data message is transmitted after the voice channel has been set up already, and the data message is output **to the voice channel** to be properly handled by whoever appears at the other end of the voice channel. Preston continuously emphasizes that the data message must be sent in-band with the telephone call (see e.g. title; Abstract; col. 1, lines 20-24).

The approach taken in Preston ensures that the transmission medium (e.g., the voice channel) is there ready and waiting when transmitting the data message, which means that no

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1 *In Re Fine, 5 U.S.Q.2d 1596, 1598 (Fed. Cir. 1988); In Re Wilson, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); Agmen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); In Re Sang Su Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).*

destination address needs to be determined for it.

The Examiner argues that Lielbriedis teaches:

> "identifying information is transmitted to a mobile communication station in the originating address data space of a short message. At a later stage when the mobile response to the message, the received originating address will constitute the destination address and the identifying information will be returned from the mobile station in the destination address data space of the response... information in data communication is sent automatically in a response to the originating terminal which sent the data".

Assuming, arguendo, that Lielbriedis discloses transmitting the sender's address in a short message so that the recipient of the short message can read it from there and use it when transmitting a response (which the Applicants do not so assert), this solution is inherently incompatible with Preston, and even if combined thereto would not result in claim 1.

Firstly, Lielbriedis suggests using a first data message (such as SMS or USSD) to convey the address to be used in the second, responding data message. Because Lielbriedis never mentions any telephone call in combination with any data message, Lielbriedis would be inherently incompatible with Preston, which discusses sending a data message in association with a telephone call.

Secondly, in Preston the data message is sent during the telephone call. Lielbriedis suggests first conveying one data message from A to B, then making B read the address of A from the message, and only subsequently transmitting a response message from B to A. No transmission of a data message is described as taking place during another transmission in Lielbriedis. For at least this reason, Lielbriedis is inherently incompatible with solutions such as Preston, in which the telephone call and the transmission of the data message take place at the same time.

In Lielbriedis, the data message is transmitted as a standalone transmission, which means that it is inherently in-band (because every transmission is in-band with itself, and because Lielbriedis does not consider any other transmissions).

Clearly, Lielbriedis does not disclose or suggest "storing, **as a consequence of the telephone call**, identifier data" and "using **the stored identifier data** to determine automatically a destination address for a data message" as in claim 1.

As neither Preston nor Lielbriedis disclose or suggest "storing, as a consequence of the telephone call, identifier data" and "using the stored identifier data to determine automatically a destination address for a data message" as in claim 1, the combination of Preston and Lielbriedis (which the Applicants do not assert there is a motivation to so combine or that such a combination is feasible), herein Preston-Lielbriedis, also does not disclose or suggest these elements of claim 1. As Preston-Lielbriedis does not disclose or suggest all elements of claim 1, claim 1 is not made obvious by Preston-Lielbriedis. For at least this reason, claim 1 is in condition for allowance.

Even if it were possible to combine Preston with Lielbriedis, the result would not be claim 1. As pointed out above, an inherent feature of Preston is the absolute redundancy of any separate address for the data message. Thus, if the alleged combination included a need for a separate address, not to speak of any mechanism for determining it, these should both come from Lielbriedis. An alleged combination of Preston and Lielbriedis would include first receiving a data message including an address from the other party, then making a telephone call, and during the telephone call sending a data message to the address that was received in the first data message. All such solutions would still fail to disclose the claimed feature of determining the destination address by using the identifier data that was stored **as a consequence of the telephone call**.

Additionally, the Examiner states: "Lin teaches the transfer of data between the two stations and it can obviously be seen that the address of the two mobiles is being used in the exchange as destination addresses for the communication" (see page 3). However, Lin is not used as a basis for the rejection, further, Lin has been shown as being not valid prior art against this application.

As claims 12 and 33-34 recite similar language to that discussed above with reference to claim 1, claims 12 and 33-34 are likewise in condition for allowance. Claims 2-5, 8-11, 13-14 and 16-19 depend upon claims 1 and 12. For at least this reason, they are likewise in condition for allowance.

As seen above, Preston-Lielbriedis does not disclose or suggest claims 1 and 12. As claims 1 and 12 are allowable over Preston-Lielbriedis then all claims that depend from claims 1 and 12 should also be allowable over Preston-Lielbriedis, whether considered alone or in combination with other art cited as applied by the Examiner. Further, the addition of the disclosure of Paik to Preston-Lielbriedis (without admitting that such combination is suggested or technically feasible), would not cure the deficiencies in the disclosure of Preston-Lielbriedis. For at least this reason, claims 36-38 are in condition for allowance.

In light of the discussion above, the Applicants respectfully assert that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicants respectfully request that the Examiner reconsider and withdraw these rejections to claims 1-5, 8-14, 16-19, 33-34 and 36-38.

Rejection of claims 29-32 and 35

In the Office Action Summary the Examiner indicates that "Claim(s) 1-5, 8-14, 16-29 and 31-38 is/are rejected". However, the Examiner does not provide any explanation of the rejections to 20-32 and 35 in the Detailed Action.

Claims 20 and 28 are independent claims. Claims 21-27 refer directly or indirectly to claim 20. Claims 29, 31-32, 35 and 41 refer directly or indirectly to claim 28. In the absence of any reasons of rejection, the Applicants consider claims 29, 31-32, 35 and 41 to be allowed, and respectfully requests the Examiner to confirm this status.

If the Examiner does not agree upon the allowable status of claims 29, 31-32, 35 and 41, the Applicants respectfully request the Examiner to provide a detailed explanation of the rejections to these in claim in a new Non-Final Office Action.

Newly added claims 39-40 recite similar language to that discussed above with reference to claim 1. Claims 39-40 are likewise in condition for allowance for at least this reason.

For the foregoing reasons, the Applicants believe that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.
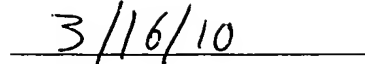
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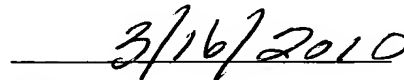Telephone: (203) 925-9400 x24

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